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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,305	07/09/2001	Wayne Anderson	P-14 (n) CIP / CONT	8578

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EXAMINER

MEISLIN, DEBRA S

ART UNIT

PAPER NUMBER

3723

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,305

Applicant(s)

ANDERSON ET AL.

Examiner

Debra S. Meislin

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 92-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 92-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

1. Claims 94 and 98-100 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 94, 98, and 100 "wing member extending between the closed-end and the tubular body", "wing member edge being disposed between the closed-end and the tubular body", and "wing member edge...extends from the closed end to the tubular body" is misdescriptive, lacks antecedent basis in the specification, and is not found in the original disclosure.

2. Claims 92-101 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 92, line 13, "closed end" should be --said closed end--.

Claims 94, 98, and 100 are vague and indefinite for the reasons set forth in paragraph 1, above.

In claim 96, "a cylinder" appears to be redundant in view of the recitation of a "tubular" body.

In claim 97, lines 2-4, "said double-ended tool being...position" is redundant in view of claim 92.

In claim 98, line 11, antecedent basis for "said member" is not clear since "a wing member" and "tool bit member" have been previously defined.

Art Unit: 3723

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 92-96, 98 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison et al (6,009,582) in view of Beran (2,980,996).

Figure 17 of Harrison et al discloses all of the claimed subject matter except for having a closed end of the sleeve non-removably connected to the means for pivotally connecting the sleeve and being pivotable to an inoperative position between the handle sides, and bits and sleeves stored in the handle. Beran discloses a closed end non-removably connected to the means for pivotally connecting the sleeve and being pivotable to an inoperative position between the handle sides. It would have been obvious to one having ordinary skill in the art to form the sleeve of Harrison et al with a closed end non-removably connected to the means for pivotally connecting the sleeve and being pivotable to an inoperative position between the handle sides to store the sleeve as taught by Beran.

Beran further discloses bits and sleeves stored in the handle. It would have been obvious to one having ordinary skill in the art to form the device of Harrison et al such that the bits and sleeves are stored in the handle to allow for the storage of bits within the handle as taught by Beran.

Art Unit: 3723

5. Claim 97 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison et al (6,009,582) in view of Beran (2,980,996) as applied above, in further view of Park (5,280,659).

Park discloses a double-ended tool bit. It would have been obvious to one having ordinary skill in the art to form the bit of Harrison et al as double-ended to allow for added versatility as taught by Park.

6. Claim 99 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison et al (6,009,582) in view of Beran (2,980,996) as applied above, in further view of Rocca (4,448,097).

Rocca discloses a second sleeve. It would have been obvious to one having ordinary skill in the art to provide the device of Harrison et al with a second sleeve for added versatility and storage as taught by Rocca.

7. Claim 101 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison et al (6,009,582) in view of Beran (2,980,996) as applied above, in further view of Esquire, Park (5,280,659), Beck (5,432,968), Cachot (5,809,600), or Dahlquist (614,573).

Esquire, Park, Beck, Cachot, or Dahlquist disclose asymmetrical handles. It would have been obvious to one having ordinary skill in the art to form the device of Harrison et al with asymmetrical handles to provide limited bulk and storage in only one handle as taught by Esquire, Park, Beck, Cachot, or Dahlquist.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3723

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Applicant's arguments filed December 26, 2002 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims set forth in a related application are not on point since each application will be examined on its own merits.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is some teaching, suggestion, or motivation to do so found in the references themselves. A closed end non-removably connected to the means for pivotally connecting the sleeve and being pivotable to an inoperative position between the handle sides are taught by Beran to store the sleeve and bits within the handle.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

Art Unit: 3723

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Combining the teachings of the applied references does not render Harrison et al inoperable.

Beran was applied to the rejection of the claims to teach the concept of having a closed end non-removably connected to the means for pivotally connecting the sleeve, and the sleeve and tool bit being pivotable to an inoperative position between the handle sides for the storage thereof. Beran was not applied to teach what was disclosed by Harrison et al.

10. Any inquiry concerning this communication should be directed to Debra S. Meislin at telephone number 703-308-3671.



Debra S. Meislin
Primary Examiner
Art Unit 3723

February 24, 2003